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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,053	02/04/2004	Kazuya Hisada	10873.0712USD2	5474
23552	7590	09/12/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			SCHATZ, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/773,053

Applicant(s)

HISADA ET AL.

Examiner

Christopher T. Schatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/24/06, 3/31/06</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 8/9/04, 2/24/04</u>               |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 11-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,743,527. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method recited by claims 1-6 of the cited U.S. Patent encompasses all of the limitations required in claims 11-15 and 18-22 of the instant application.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11-14 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Furuki et al. (JP 10-283683).

Applicant should note that examiner is referring to the attached English Translation of Furuki et al. Furuki et al. discloses a method for producing an optical disk including a first substrate 21 having a central hole D2 and a second substrate that is transparent and has a central hole D4 whose diameter is larger than that of the central hole D2, comprising the processes of: (a) bringing the first substrate having a signal area on a principal plane and the second substrate that is thinner than the first substrate into contact with each other with radiation curable resin interposed there between so that the principal plane faces inside; and (b) irradiating the radiation curable resin with radiation to cure the radiation curable resin, thereby attaching the first substrate to the second substrate, wherein, in the process (a), the radiation curable resin is disposed so as to extend at least from an inner peripheral edge of the second substrate to an outer peripheral edge thereof (paragraphs 0015-0022, 0028, 0031, 0036-0040, 0054-0077, figures 4, 9, 13, 14, 15, and 18). As to claim 12, Furuki et al. discloses a method for producing an optical disk wherein a thickness of the second substrate is in a range of 0.03 mm to 0.3 mm (paragraph 0039). As to claim 12, Furuki et al. discloses a method for producing an optical disk wherein the process (a) includes interposing the radiation curable resin between the first and second substrates, and rotating the first and second substrates to draw the radiation curable resin

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(paragraphs 0042-0044). As to claim 14, Furuki et al. discloses a method for producing an optical disk wherein the process (a) includes pouring the radiation curable resin onto the first substrate, rotating the first substrate to coat the first substrate with the radiation curable resin, and bringing the first substrate and the second substrate into contact with each other with the radiation curable resin interposed there between (paragraphs 0062-0068, figures 10-15).

As to claim 18, Furuki et al. discloses a method for producing an optical disk, comprising the processes of: (A) bringing a first substrate having a signal area on a principal plane and a central hole D2 and a second substrate that is transparent and thinner than the first substrate into contact with each other with radiation curable resin interposed there between so that the principal plane faces inside; (B) irradiating the radiation curable resin with radiation to cure the radiation curable resin, thereby attaching the first substrate to the second substrate; and (C) removing a part of the second substrate to form a central hole D4 whose diameter is larger than that of the central hole A in the second substrate (paragraph 0038, figure 3), wherein, in the process (A), the radiation curable resin is disposed so as to extend at least from an outer periphery of a position where the central hole B is formed to an outer peripheral edge of the second substrate. (paragraphs 0015-0022, 0028, 0031, 0036-0040, 0054-0077, figures 4, 9, 13, 14, 15, and 18). Applicant should note that claim 18, as currently written, *does not require* steps (A)-(C) to be performed in any particular order. Furuki et al. meets the limitations of claims 19, 20, and 21 for the reasons set forth in the above discussion of claims 12, 13, and 14, respectively.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furuki et al.

Furuki et al. discloses method as discussed above. The reference further discloses a method of producing an optical disk wherein the first substrate includes a portion 23 in a circular shape so as to surround a central hole D2, said portion having an outer diameter equal to or smaller than a diameter of a second central hole D4 (figure 9, paragraph 0054-0058). Furuki et al. discloses that the portion 23 is for excess resin. The reference does not explicitly disclose that the portion is concave. However, examiner takes Official Notice that it would have been readily apparent to one of ordinary skill in the art to form a concave portion as such a method is well known in the art. Regardless of the exact shape of the portion 23, said portion serves the same purpose of holding excess resin. Absent any unexpected results that demonstrate a concave portion is advantageous over the shape disclosed by Furuki et al., it would have been obvious to one of ordinary skill in the art at the time the invention to form a concave portion as a concave portion achieves the same result as the portion explicitly disclosed by Furuki et al. As to claim 17, applicant is notified that the claim is optionally since claim 16 does not require the presence of a convex portion.

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7. Claims 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furuki et al., as applied above, and in further view of Kakinuma '777.

Furuki et al. discloses a method as stated above, but the reference is silent as to a method wherein the two substrate are contact is a vacuum atmosphere. Kakinuma discloses a method wherein of manufacturing an optical disk wherein two substrate are contacted together in a vacuum. Kakinuma further discloses that contacting two optical disk substrates in a vacuum prevents air from being trapped between the substrates and reduces the risk of disk deformation (column 4, lines 15-22). At the time of the invention it would have been obvious to a person of ordinary skill in the art to contact the two substrates of Furuki et al. in a vacuum as taught by Kakinuma above. Such a modification to the method of Furuki et al. would prevent air bubbles from being trapped in between said substrates and reduce the risk of disk uniformity.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Christopher T. Schatz** whose telephone number is **571-272-1456**. The examiner can normally be reached on 8:00-5:30, Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christopher T. Schatz



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